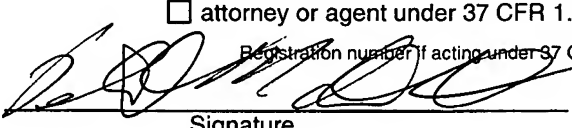


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JUN 06 2008  
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<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b> <b>FY 2006</b> <b>(fees effective on or after December 8, 2004)</b>		Docket Number (Optional) 006329.00005																								
Application Number 10/521,139		Filed 12 January 2005																								
For Picture Frame																										
Art Unit TBD	Examiner Smith, Anthony																									
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.																										
The requested third month extension and fee are as follows (check time period desired and enter the appropriate fee below):																										
<table border="0" style="width: 100%;"> <tr> <td></td> <td style="text-align: center;"><u>Fee</u></td> <td style="text-align: center;"><u>Small Entity Fee</u></td> <td></td> </tr> <tr> <td><input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))</td> <td style="text-align: center;">\$120</td> <td style="text-align: center;">\$60</td> <td style="text-align: center;"><u>\$60</u></td> </tr> <tr> <td><input type="checkbox"/> Two months (37 CFR 1.17(a)(2))</td> <td style="text-align: center;">\$460</td> <td style="text-align: center;">\$230</td> <td style="text-align: center;">\$_____</td> </tr> <tr> <td><input type="checkbox"/> Three months (37 CFR 1.17(a)(3))</td> <td style="text-align: center;">\$1050</td> <td style="text-align: center;">\$525</td> <td style="text-align: center;">\$_____</td> </tr> <tr> <td><input type="checkbox"/> Four months (37 CFR 1.17(a)(4))</td> <td style="text-align: center;">\$1640</td> <td style="text-align: center;">\$820</td> <td style="text-align: center;">\$_____</td> </tr> <tr> <td><input type="checkbox"/> Five months (37 CFR 1.17(a)(5))</td> <td style="text-align: center;">\$2230</td> <td style="text-align: center;">\$1115</td> <td style="text-align: center;">\$_____</td> </tr> </table>		<u>Fee</u>	<u>Small Entity Fee</u>		<input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$120	\$60	<u>\$60</u>	<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$460	\$230	\$_____	<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$1050	\$525	\$_____	<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$1640	\$820	\$_____	<input type="checkbox"/> Five months (37 CFR 1.17(a)(5))	\$2230	\$1115	\$_____		
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<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.																										
<input type="checkbox"/> A check in the amount of the fee is enclosed.																										
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.																										
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.																										
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>19-0733</u> . I have enclosed a duplicate copy of this sheet.																										
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>																										
I am the <input type="checkbox"/> applicant/inventor.																										
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71																										
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).																										
<input checked="" type="checkbox"/> attorney or agent of record. Registration Number <u>29,411</u>																										
<input type="checkbox"/> attorney or agent under 37 CFR 1.34.																										
Registration number if acting under 37 CFR 1.34. _____																										
 Signature	June 6, 2008 Date																									
Peter D. McDermott _____ Typed or printed name	(617) 720-9600 _____ Telephone Number																									
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.																										
<input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.																										

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Gredley, Sarah

**Serial No.:** 10/521,139

**Filing Date:** 12 January 2005

**For:** Picture Frame

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**JUN 06 2008**

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**RENEWED REQUEST FOR RECONSIDERATION**

**RENEWED PETITION UNDER 37 CFR § 1.137(b)  
TO REVIVE AN UNINTENTIONALLY ABANDONED APPLICATION**

Mail Stop PCT  
Commissioner for Patents  
Office of PCT Legal Administration  
Post Office Box 1450  
Alexandria, Virginia 22313-1450

Attention: Office of PCT Legal Administration

Sir:

This renewed request for reconsideration is filed in response to the Decision on Petition under 37 CFR 1.137(b) mailed on March 6, 2008. Applicant appreciates the telephonic indication to the undersigned of a one-month extension of time from the Office of PCT Legal Administration. A Petition for Extension of Time under 37 C.F.R. 1.136(a) is filed with this paper. The Commissioner is hereby authorized to charge such extension fee or credit any overpayment of fees to Deposit Account No. 19-0733.

Applicant respectfully requests reconsideration of her previously filed petition under 37 C.F.R. § 1.137(b) to revive PCT application PCT/GB03/02228 (the "PCT

application”). Applicant seeks co-pendency with the above-captioned application in order to secure priority benefit of the PCT application. Applicant never made a conscious and deliberate decision to allow the application to become abandoned. Rather, the PCT application became unintentionally abandoned through inadvertent “out-of-sight, out-of-mind” inattention.

### **Procedural Background**

This petition to revive was filed on January 12, 2005, concurrent with the filing of the continuation application. The petition was dismissed in a Decision on Petition mailed on January 4, 2006. A first request for reconsideration and renewed petition was filed on March 6, 2006 with additional information, including a Declaration by the Applicant. The petition was again dismissed in a Decision on Petition mailed on August 9, 2006. A second request for reconsideration and renewed petition to revive was filed on November 8, 2006. The Decision mailed on March 6, 2008 dismissed the renewed petition without prejudice. As noted above, this Renewed Request for Reconsideration and Renewed Petition is filed in response to that Decision of March 6, 2008.

This Renewed Request for Reconsideration is supported by all of the papers filed to date in this application, including a Declaration of the Applicant-inventor, Sarah Gredley, included as Attachment A to the first request for reconsideration.

Renewed Request For Reconsideration  
Renewed Petition Under 37 CFR § 1.137(b) to Revive  
an Unintentionally Abandoned Application

In addition, as suggested in the August 9, 2006 Decision on Petition, Applicant has previously filed with the second request for reconsideration, a copy of the instructions provided to her by Barker Brettell regarding national phase filings corresponding to the PCT application. As previously detailed, the Barker Brettell communication providing instructions to the Applicant regarding national phase filings has attorney-client privileged content, and so is selectively redacted to properly protect the interests of the Applicant. A Declaration by the Barker Brettell firm also was filed at that time, setting forth that the redacted content is not relevant to the clarity of the instructions provided regarding the timing requirements of a US national phase filing corresponding to the PCT application.

**No Decision to Abandon**

The fundamental fact supporting revival of the PCT application for co-pendency is that the applicant never made a conscious and deliberate decision to allow the application to become abandoned. The March 6, 2008 Decision cites the discussion of the meaning of "unintentional" in the Changes to Patent Practice and Procedure; Final Rule Notice, specifically, that a delay resulting from a deliberately chosen course of action does not become an "unintentional delay" within the meaning of 37 CFR 1.137(b) because the applicant simply seeks to defer patent fees and prosecution expenses. That is not the case here. The applicant, Ms. Gredley, had no deliberately

chosen course of action to delay or defer expenses. Rather, the Declarations and facts in the record of this case show the lack of a deliberately chosen course of action due to mistaken belief that the time for decision had not been reached and consequent inattention.

The Decision cites applicant's statement, that the delay was "due to mistaken believe that the US National Phase application could be filed later." The Decision wrongly finds support in that statement for the conclusion that the delay was a deliberate course of action. Quite the contrary, the delay was not a deliberate course of action. It was the lack of a deliberate course of action. It was the consequence of inattention. Ms. Gredley's mistaken belief was that her patent application matters could safely be left for later.

Nothing of record in this case supports a finding of a conscious and deliberate decision to allow the PCT application to become abandoned. Rather, applicant did not monitor the deadline because she thought, albeit wrongly and due to lack of familiarity with patent law and practice, that this was a task that could be addressed at a later time. Against the backdrop of a prolonged PCT proceeding in which various dates could be extended or safely ignored, Ms. Gredley failed to appreciate the deadline for filing a US National Phase application corresponding to the PCT application. Ms. Gredley says in her Declaration that she failed to appreciate that the national phase deadline for filing a US filing was non-

extendable, and certainly it is understandable that a neophyte such as Ms. Gredley could make that mistake.

Further militating against a finding that the delay was purposefully chosen, is the fact that the deadline was missed due to the applicant being extraordinarily busy and stressed at that time of her life with business matters, as set forth in her Declaration. Here, again, there was no deliberate decision to abandon the PCT application, nor any deliberate course of action to delay or defer the necessary steps to initiate the subject US patent application. Rather, she simply could not address everything immediately and some things had to be addressed later. Ms. Gredley's mistaken belief that the application could be filed later conspired with this overload to put the application matter out-of-sight and out-of-mind. Her ability under the circumstances to do only so many things at once resulted in the matter of following through with instructions to proceed in the US being missed.

Essentially, because she misunderstood the nature of a patent filing due date and mistakenly believed that action could be taken later, this was the ball that was allowed to drop. It may be notable here, that any novice in PCT matters can easily be confused by extendable and non-extendable deadlines. The deadline in this case is in contrast to many other countries which have longer deadlines and/or grace periods, and is also in contrast to the previous Article 19 and Article 31 PCT deadlines, where the deadlines could safely be allowed to pass.

Further, prompt action has been taken throughout this petition process. The Barker Brettell firm contacted the undersigned to initiate efforts on November 29, 2004, and instructed the filing of the US national phase application on November 30, 2004. This was only a week after the 30 month deadline of November 23, 2004, which is not a long delay. The patent application and the Petition to Revive, including Exhibits, were promptly prepared. They were completed and filed on January 12, 2005.

#### **Case Law Supporting Revival of the Application**

Understandably, the decisions in this area are dependent upon their individual facts. Overall, however, there is support for revival of the PCT application in this case. The decision in *In re Goodman*, 3 USPQ2d 1866, 1872 (Comm'r Pat. 1987) revived an application, *nunc pro tunc*, where the Commissioner found that the "record makes it manifest that applicants did not intend the application to become abandoned."

Following appeal to the Federal Circuit of an affirmance by the Board of a final rejection, the Office requested and received remand of the case to the PTO to consider whether the application should be held abandoned for her failure to respond properly to a rejection presented in the first Office action. The Office issued an order to show cause why the application should not be held abandoned. The application then was held abandoned. On petition to the Commissioner to waive abandonment and to revive

Renewed Request For Reconsideration  
Renewed Petition Under 37 CFR § 1.137(b) to Revive  
an Unintentionally Abandoned Application

the application, the petition to revive was granted. The decision notes the late stage of the proceedings in which the issue of the abandonment was raised, but pertinent to this case, as noted above, the Commissioner's reasoning focused on the fact that the "record makes it manifest that applicants did not intend the application to become abandoned."

So, too, here, the record makes it manifest that Ms. Bradley did not intend the application to become abandoned. Ms. Gredley indicated to her British counsel in a telephone conversation on September 30, 2004, that she intended to proceed with the US National Phase of the PCT application, that she was interested in proceeding with patent protection for her picture frame invention in at least Europe and United States (Gredley Declaration, paragraph 10.) Applying *Goodman's* focus on the manifest intent of the applicant, the subject application should be revived.

A similar principle is applied in *Lee v. Dryja*, 79 USPQ2d 1614 (Bd. Pat. App. & Int. 2005) (nonprecedential) where the motion of a junior party to an interference was granted, permitting late payment of a maintenance fee and reinstatement of the patent under 37 CFR 1.378(c). The Board relied upon evidence establishing that the delay in payment of the maintenance fee likely occurred as a result of a docketing error and that the patentee promptly filed the petition for reinstatement once it became aware of the failure to pay the fee in a timely manner. The Board reasoned that there was no evidence showing that the patentee deliberately failed to pay the maintenance fee. Likewise in this case, there is no evidence showing that Ms. Gredley deliberately failed



to timely file the present application to obtain the priority benefit of the PCT application. Also, as in *Lee*, the applicant acted promptly once she became aware of the PCT application becoming abandoned.

**Preliminary Amendment**

As suggested in the August 9, 2006 Decision on Petition, Applicant included with the second request for reconsideration and renewed petition, a further preliminary amendment to restate the claim for priority benefit added to the first page of the specification by prior preliminary amendment.

**Petition under 37 CFR 1.78(a)(3)**

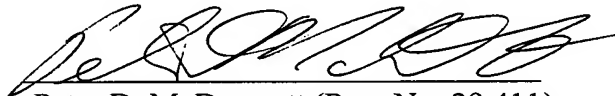
As also suggested in the August 9, 2006 Decision on Petition, Applicant included with the second request for reconsideration and renewed petition, a petition under 37 CFR 1.78(a)(3) for the acceptance of an unintentionally delayed claim for priority. That petition was made conditionally. The March 6, 2008 Decision held that petition in abeyance, and applicant requests that it be considered upon granting of this petition.

**Conclusion**

The Applicant, Sarah Gredley, earnestly requests that this request for reconsideration and renewed petition to revive the unintentionally abandoned application be granted. She acted very promptly after the unintentional abandonment was realized. Applicant submits that she has complied with the provisions of 37 CFR § 1.137(b) and respectfully requests revival of the application.

Respectfully submitted,

Dated: June 6, 2008



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